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Typed Name: Kevin D. McCarthy
Date: November 22, 2010

Patent

0-06-177 - 14429/US/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Shoshan-Bar-Matz et al.
Serial no.: 10/589,170
I.A. Filed: February 17, 2005
Title: PHOTOREACTIVE COMPOUND SPECIFICALLY
BINDING TO CALCIUM BINDING PROTEINS
Examiner: Gregorio
Art Unit: 1732
Confirmation 6954

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

RESPONSE

This response is in reply to the office action mailed on October 8, 2010. Applicant also encloses a petition for a one month extension of time to file this response with the appropriate small entity fee.

In the office action, the Examiner asserts there are five different searchable inventions, which are as follows:

- Group I: claims 1-12, covering azido compound;
- Group II: claims 13-17, covering method of isolating Ca-binding protein;
- Group III: claim 18, covering method of characterizing the isolated protein;
- Group IV: claims 19-21, covering the preparation of a chip comprising said compound; and
- Group V: claims 22-25, covering method of screening for Ca-binding proteins.

The Examiner does not mention claims 26-39, and we assume that the subject matter of claims 26 to 39, which were submitted on August 11, 2006 in a preliminary amendment filed with the original application and April 16, 2007; belong to the above five groups. The Examiner states that the above groups do not relate to a single general inventive concept, citing Siebald [Polyhedron 15 (1996) 4221-5] and Gincel [Biochem J. 358 (2001) 147-55], and opining that Siebald discloses ruthenium complex, while Gincel (Inventor's article) allegedly discloses binding of ruthenium complexes to proteins.

The applicant respectfully traverses the examiner's position, as the published ruthenium compounds are structurally different from the instant compounds, and they are, moreover, not photoreactive as the instant compound; however, one group of claims is now elected as requested. The election is made with traverse.

In the amended set of claims, previously presented claims 1-39 have been withdrawn and new claims 40-50 have been added. The subject matter of new claims

40-50 comprises the subject matter of claims 4-11 and 34-37 of the present US publication (US 2007/0298120) as follows:


New claim 40 combines the material of previous claims 4 and 10,
New claims 41-45 comprise the language found at previous claims 5-9;
New claim 46 comprises the language found at previous claim 11, and
New claims 47-50 comprise the language found at previous claims 34-

37.

Applicant, solely to comply with the restriction requirement to expedite this prosecution, elects Group I. However, the claims are amended to emphasize the feature of inhibiting Ca-binding proteins by the instant Ru-compounds, wherein said inhibiting was defined in previous claim 10 and said compounds in previous claims 4-9. The feature of inhibiting is broadly supported in the specification, for example and not limited to in paragraphs 0003, 0008, 0026, 0029, 0033, and importantly in paragraph 0011 and in the original claims.

Since the subject matter of new claims 40-46 essentially covers the subject matter of claims included by the Examiner in her Group I, it is believed that new claims 40-46 will be accepted by the Examiner, and hopefully allowed. As for new claims 47-50, they cover the subject matter not mentioned by the Examiner in the Restriction Requirement, but it is believed that all new claims 40-50 clearly relate to one inventive concept. It is respectfully requested that the Examiner kindly call the patent attorney if the applicant's amendments should be restructured.

Respectfully submitted



Kevin D. McCarthy
Reg. No. 35,278

Roach, Brown, McCarthy & Gruber, P.C.
1920 Liberty Building - 424 Main Street
Buffalo, New York 14202